

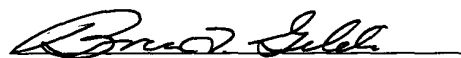
BP9901-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/593,914 Confirmation No: 8319
Date Filed: June 14, 2000
Application Title: Probes, Probe Sets, Methods And Kits Pertaining To The
Detection, Identification And/Or Enumeration Of Yeast;
Particularly In Wine
Applicants: Hyldig-Nielsen et al.
Group Art Unit: 1634
Examiner: C. Myers
Action Date: February 25, 2003
Action Type: Third Office Action On Merits - FINAL
Certified Mail No.: 7003 0500 0000 1731 7079

Certificate of Mailing Pursuant to:
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop: AF, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of August, 2003.


Brian D. Gildea
Reg. No. 39,995

Petition Under 37 C.F.R. § 1.144

Commissioner for Patents
Dear Sir or Madam:

Preliminary Statement

Applicants hereby petitions for review of the Examiner's decision with regard to a restriction requirement as set forth in Office Action paper No. 9. Applicants did enter traverse of the restriction requirement as well as make appropriate argument and request for consideration, in reply to said Office Action, by submission dated January 17, 2002. The Examiner has, based upon 35 U.S.C. § 121, attempted to restrict subject matter (e.g. each of 11 different Seq. ID Nos.) within a single claim. For the reasons stated in the argument presented below, Applicants traverse this restriction requirement and

therefore request that the Examiner be compelled to withdraw said restriction requirement.

Argument In Support Of Request To Withdraw Restriction Requirement

In the Office Action of Paper No. 9, the Examiner took the position that, with respect to claims 10, 11, 21, 22, 34, 61 and 62, Applicants presented claims in improper Markush format. The Examiner cited to *Ex parte Markush*, 1925 C.D. 126 and *In re Weber*, 198 U.S.P.Q. 334 as legal support for this position. The Examiner's argument also relied upon 35 U.S.C. § 121 as statutory support for the restriction requirement. However, the proper citation to *In re Weber* is 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA, 1978). Nevertheless, the case cited at 198 U.S.P.Q. 334 (*In re Haas*) does pertain to same question or law.

Applicants hereby respectfully traverse the present restriction requirement as being clearly contrary to the express holding of both *In re Weber* and *In re Haas*. *In re Weber* expressly holds that:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be "independent and distinct". It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis. *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, __ (CCPA, 1978)

We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses (emphasis added). *In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, __ (CCPA, 1978)

Accordingly, it is clear from the precedent cited by The Office, the legal issue of whether or not The Office may impose a restriction requirement to a single claim has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 112, where the applicant is statutorily entitled to claim his invention as he deems

proper notwithstanding 35 U.S.C. § 121. This is true whether or not the inventions are determined by The Office to be independent and distinct. Accordingly, it is improper for the Examiner to demand that the claims be amended to redact all Seq. ID Nos., other than Seq. ID No. 1, from any of claims 10, 11, 21, 22, 34, 61 or 62.

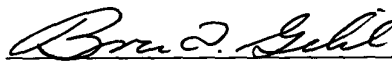
Applicants further note that in each Group that the Examiner argues is a separate invention (each distinct Seq. ID No. (e.g. 1-11)) is classified in Class 435, subclass 6 and Class 536, subclass 24.32. Thus, for purposes of a search, there is no additional burden on The Office since the same class and subclasses must be searched, and no additional Class or subclass must be searched, whether or not a restriction requirement is imposed.

Additionally, Applicants take the position that said claims are generic and use proper Markush format. Accordingly, Applicant takes the position that the present restriction requirement is improper and therefore request that it be withdrawn.

Fees

The Office is hereby authorized to deduct the required fee for consideration of this petition, believed to be \$ 130.00, from Deposit Account No. 02-3240.

Respectfully submitted
On behalf of Applicants,


Brian D. Gildea; Reg. No. 39,995